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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,512	08/07/2003	Joseph R. Pearce	02878.000200	8447
5514	7590	05/18/2004		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER SZUMNY, JONATHAN A	
			ART UNIT 3632	PAPER NUMBER
DATE MAILED: 05/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/635,512

Applicant(s)

PEARCE, JOSEPH R.

Examiner

Jon A Szumny

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5, 14-16 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/16/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

This is the first office action for application number 10/635,512, Wrist Rest, filed on August 7, 2003.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, drawn to a wrist rest, classified in class 248, subclass 118.
- II. Claim 20, drawn to a wrist rest in a packaging material, classified in class 248, subclass 118.

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination such as the "soft body," "inner cavity," and the "three dimensional outer covering". The subcombination has separate utility such as for use as a wrist rest without having to take the wrist rest out of the packaging first.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Michael O'Neill on May 14, 2004 a provisional election was made without traverse to prosecute the invention of I, claims 1-19. Affirmation of this election must be made by applicant in replying to this Office

action. Claim 20 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Further, this application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: The wrist rest of figures 1-2;

Species 2: The wrist rest of figure 3;

Species 3: The wrist rest of figure 4

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 9 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Michael O'Neill on May 14, 2004 a provisional election was made without traverse to prosecute the invention of Species I, claims 1-4, 6-13 and 17-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5 and 14-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

Claims 2-8 and 10-19 are objected to because of the following informalities:

In claims 2-8 and 10-19, line 1, "A" should be --The--;

In claim 12, line 1, "character" should be --the character--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7, 8, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 7 and 18, the specification taught (on page 5) the length of the wrist rest to be "approximately 9 or 10 inches," but never taught the length to be "approximately 7 to 10 inches" as recited in claims 7 and 18.

Similarly, regarding claims 8 and 19, the specification taught (on page 5) the width of the wrist rest to be "preferably around 3.5 to 4 inches wide," but never taught the width to be "(approximately) 2-5 inches" as recited in claims 7 and 18.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 2, 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites "the user's wrist" in line 3 while claim 11 recites the limitation "the animal" in line 1. There is insufficient antecedent basis for these limitations in the claims.

Regarding claim 12, it is not completely understood what is meant by a "cartoon character," and how such is different than just a "character". The specification gave no clarification as to exactly what a "cartoon character" is. For the purposes of this office action, the Examiner will assume that a "cartoon character" is a character that can cartoon or could be used as a cartoon.

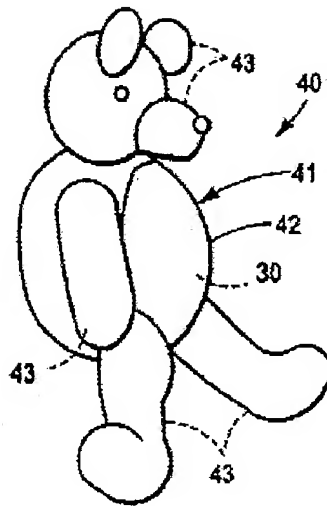
### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent number 6,672,932 to Panec et al.



Panec et al. '932 discloses a device (above) that inherently functions as a wrist rest comprising a soft body (column 4, line 39, "furry") having an inner cavity (30) and a three dimensional outer covering (column 4, lines 37-40), the inner cavity containing a moldable shape-retaining cushion (gel, column 3, line 36, with reference to Merriam Webster's Collegiate Dictionary - 10<sup>th</sup> Edition, "moldable" means "to give shape to", so clearly, a shape can be given to gel, and for instance, when a user presses and holds the gel area, a shape is retained), wherein the three dimensional outer covering has the appearance of a novelty character/bear/animal, wherein the three dimensional outer covering is formed from a stretchable/soft/plush/fabric-like material for contact with a user's wrist ("furry fabric", column 4, line 39, "stretchable" column 5, line 63), wherein the three dimensional outer covering is stuffed with a filling material (column 4, lines 46-48), wherein the device has a longitudinally extending central portion shaped as the torso of the character and is formed with a moldable shape retaining cushion with an internal gel cell (column 4, lines 37-40), wherein the device includes first and second



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peripheral portions (head and limbs, above) shaped as the extremities of the character, wherein the character is inherently usable as a cartoon character.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 8, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panec et al. '932.

Panec et al. '932 fails to specifically teach the device to have a length of approximately 7 to 10 inches or a width of 2-5 inches. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the length and width of the device of any number of various dimensions, including approximately 7 to 10 inches or 2-5 inches, respectively, because doing so is considered a design choice and hence not considered patentable since the applicant has not specifically recited in the originally filed specification why such dimensions are critical to the invention or produce any unexpected result (as mentioned in the 112 - 1<sup>st</sup> paragraph rejection above, the applicant never even described all of such dimensions in the specification; additionally, although the applicant mentioned that certain specific dimensions in the range claimed above provide "adequate support", it is never

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discussed exactly how they provide "adequate support"). See In re Kuhle, 526 F.2d 553, 188, USPQ 7 (CCPA 1975).

Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panec et al. '932 in view of U.S. Patent number 4,968,281 to Smith et al.

Panec et al. '932 teaches the previous invention failing to specifically reveal a lower layer of weighted materials. However, Smith et al. '281 discloses a device/character (figures 1,2) including a lower layer of weighted materials (32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Panec et al. '932 so as to include a lower layer of weighted materials as in Smith et al. '281 so as to allow the legs/appendages of the character of Panec et al. '932 to more readily dangle downwardly as in Smith et al. '281 (since Smith et al. '281 teaches the lower layer of weighted material to be added to the feet of the character) which would increase the enjoyment gained by an operator of the device, in addition to providing for a more stable device.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Frye '829, Templeton '445, Blackwell '235 and DeLuca et al. '456 teach various three dimensional devices with outer coverings and inner cavities.

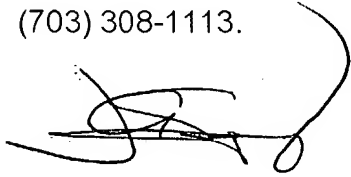
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon A Szumny whose telephone number is (703) 306-3403. The examiner can normally be reached on Monday-Friday 8-4.

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The fax phone number for the organization where this application and proceeding are assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is

(703) 308-1113.

A handwritten signature in black ink, appearing to read 'Jon Szumny', with a large, sweeping flourish extending from the end of the signature.

Jon Szumny  
Patent Examiner  
Technology Center 3600  
Art Unit 3632  
May 16, 2004